

**REMARKS**

After entry of this amendment, claims 20, 22, 24-28, 41-44, 46-50, 56-65, 67, 68, 70, 72, 73, 75-84, 86-88, 91, 92, and 94-96 will be pending for the Examiner's review and consideration. The Applicant would first like to thank the Examiner for the allowance of the subject matter disclosed in claims 23, 24, 28, 46, 50, 85, 90, and 93 if rewritten or amended to overcome the 35 U.S.C. §112¶2 rejection. The Office Action dated June 15, 2004 has been carefully considered. Claims 24, 41, 56, 59, 78, and 94 have been amended to place them in better form for acceptance and/or appeal in response to the Examiner's rejection. Claims 23, 45, 66, 69, 71, 74, 85, 89, 90, and 93 have been cancelled without prejudice. No new matter has been added. Reconsideration and allowance of the present application in view of the above amendments and the following remarks is respectfully requested.

In the Office Action dated June 15, 2004, the Examiner:

- rejected claims 45, 69, and 89 under 35 U.S.C. §112¶1 as failing to comply with the written description requirement;
- rejected claims 20, 22-28, 41-50, 56-58, 69, and 78-96 under 35 U.S.C. §112¶2 as being indefinite for failing to particularly point and distinctly claim the subject matter which applicant regards as the invention;
- rejected claims 59-67, 70-74, and 77 as being anticipated under 35 U.S.C. §102(b) by, or in the alternative, under 35 U.S.C. §103(a) as obvious over United States Patent No. 955,287 to Schofield ("Schofield");
- rejected claims 20, 22, 25-27, 41-45, 47-49, 56-58, 59-65, 67-70, 72, 73, 75-84, 86-89, 91, 92, and 94-96 under 35 U.S.C. §103 as being unpatentable over United States Patent No. 3,885,307 to Papalardo ("Papalardo"); and
- allowed the subject matter of claims 23, 24, 28, 46, 50, 85, 90, and 93 if rewritten or amended to overcome the rejections under 35 U.S.C. §112¶2.

**35 U.S.C. §112¶1 Rejection**

Dependent claims 45, 69, and 89 were rejected under 35 U.S.C. §112¶1 as failing to comply with the written description requirement. The Examiner rejected claims 45, 69, and 89 for containing subject matter which was not disclosed in the specification in such

a way as to reasonably convey to one skilled in the art that the inventors had possession of the claimed invention at the time of filing the application. It is respectfully submitted that the application as originally filed supports the recited limitations. However, in order to expedite prosecution of the present application, claims 45, 69, and 89 have been canceled without prejudice. Nothing here is to be viewed as an admission and the Applicants reserve the right to pursue the canceled claims in either a divisional, a continuation, or a continuation-in-part application, if the Applicant so desires.

### **35 U.S.C. §112¶2 Rejections**

Claims 20, 22-28, 41-50, 56-58, 69, and 78-96 were rejected under 35 U.S.C. § 112¶2 as being indefinite for failing to particularly point and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the clause "at least one outer surface" in claim 41 was rejected as rendering the claim vague and indefinite. In response thereto, "at least one" was canceled without prejudice per the Examiner's recommendation. Withdrawal of this rejection and allowance of claim 41 is therefore respectfully requested.

The clause "facing one direction" in claims 45, 69, and 89 was rejected as rendering the claims vague and indefinite. As previously stated, claims 45, 69, and 89 have been canceled without prejudice, thus these rejections are deemed moot. Withdrawal of these rejections is therefore respectfully requested.

The clause "the edge bounding the first slot" in claim 78 was rejected as rendering the claim vague and indefinite. Moreover, the clause "is non-parallel" in claim 78 was rejected as rendering the claim vague and indefinite. Furthermore, the clause "the edges" was rejected as lacking antecedent basis. In response thereto, claim 78 has been amended to make explicit what was already implicit, thus no estoppel effect should be given. Claim 78 has been amended to recite "wherein the cutting edge formed in the first slot is non-parallel with respect to the other opposing surface formed in the first slot so that the distance between the cutting edge formed in the first slot and the other opposing surface formed in the first slot decreases from the outer circumference toward the interior." Withdrawal of these rejections and allowance of claim 78 is therefore respectfully requested.

The clause "the edge bounding the first slot" in claim 94 was rejected as rendering the claim vague and indefinite. Moreover, the clause "is non-parallel" in claim 94 was rejected as rendering the claim vague and indefinite. Furthermore, the clause "the edges" was rejected

as lacking antecedent basis. In response thereto, claim 94 has been amended to make explicit what was already implicit, thus no estoppel effect should be given. Claim 94 has been amended to recite "the cutting edge formed in the second slot is non-parallel with respect to the other opposing surface formed in the second slot so that the distance between the cutting edge formed in the second slot and the other opposing surface formed in the second slot decreases from the outer circumference toward the interior." Withdrawal of these rejections and allowance of claim 94 is therefore respectfully requested.

#### **Independent Claim 41**

Independent claim 41 was rejected under 35 U.S.C. §103 as being unpatentable over Papalardo. The Applicants would first like to thank the Examiner for the allowance of the subject matter disclosed in claim 23 if rewritten to overcome the 35 U.S.C. §112¶2 rejection. It is respectfully submitted that independent claim 41 has been amended to overcome the 35 U.S.C. §112¶2 rejection. Furthermore, independent claim 41 has been amended to include all of the limitations of claim 23. Thus, it is respectfully submitted that independent claim 41 is allowable over the cited prior art. Withdrawal of this rejection and allowance of independent claim 41 is therefore respectfully requested.

Claims 20, 22, 24-28, 42-44, 46-50, and 56-58 all ultimately depend from independent claim 41, and thus, it is respectfully submitted that these claims are equally allowable for at least this reason. Withdrawal of these rejections and allowance of claims 20, 22, 24-27, 42-44, 47-49, and 56-58 is therefore respectfully requested.

#### **Independent Claim 59**

Independent claim 59 was rejected under 35 U.S.C. §103 as being unpatentable over Papalardo. Independent claim 59, which substantially includes all of the limitations of independent claim 41, has been amended to include all of the limitations of claim 71, which corresponds with allowed claim 46. Thus, it is respectfully submitted that independent claim 59 is allowable over the cited prior art. Withdrawal of this rejection and allowance of independent claim 59 is therefore respectfully requested. Alternatively, independent claim 59 has been amended to require, *inter alia*, a first shearing element comprising a first disk shaped head and a second shearing element comprising a second disk shaped head. It is respectfully submitted that Papalardo does not disclose, teach, or suggest a disk shaped head. Thus, it is respectfully submitted that independent claim 59 is allowable over the cited prior art. Withdrawal of this rejection and allowance of independent claim 59 is therefore respectfully requested.

Claims 60-65, 67, 68, 70, and 72-77 all ultimately depend from independent claim 59, and thus, it is respectfully submitted that these claims are equally allowable for at least this reason. Withdrawal of these rejections and allowance of claims 60-65, 67, 68, 70, and 72-77 is therefore respectfully requested.

#### **Independent Claim 78**

Independent claim 78 was rejected under 35 U.S.C. §103 as being unpatentable over Papalardo. The Applicant would first like to thank the Examiner for the allowance of the subject matter disclosed in claim 90 if rewritten to overcome the 35 U.S.C. §112¶2 rejection. It is respectfully submitted that independent claim 78 has been amended to overcome the 35 U.S.C. §112¶2 rejection. Furthermore, independent claim 78 has been amended to include all of the limitations of claim 90. Thus, it is respectfully submitted that independent claim 78 is allowable over the cited prior art. Withdrawal of this rejection and allowance of independent claim 78 is therefore respectfully requested.

Claims 79-84, 86-88, 91, 92, and 94-96 all ultimately depend from independent claim 78, and thus, it is respectfully submitted that these claims are equally allowable for at least this reason. Withdrawal of these rejections and allowance of claims 79-84, 86-88, 91, 92, and 94-96 is therefore respectfully requested.

In light of the above amendments and remarks, it is respectfully submitted that claims 20, 22, 24-28, 41-44, 46-50, 56-65, 67, 68, 70, 72, 73, 75-84, 86-88, 91, 92, and 94-96 are now in condition for allowance, and the Examiner is respectfully requested to reconsider this application with a view towards allowance. The Examiner is invited to call the undersigned attorney at 212-326-7883, if a telephone call could help resolve any remaining issues.

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Respectfully submitted,

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